

### **Remarks**

The Office action mailed November 17, 2004, has been reviewed and carefully considered. The specification has been amended to update the priority claim. Claims 2, 6 and 9 have been cancelled. Claims 1, 3, 5, 7 and 8 have been amended. New claims 13-23 have been added. After entry of this amendment, claims 1, 3-5, 7, 8 and 10-23 should be pending.

#### ***I. Specification***

In the specification, the priority claim has been amended to indicate that the parent application is now abandoned.

#### ***II. Claim Rejections - 35 U.S.C. § 102***

Claim 8 was rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by British Patent No. 2,143,802 (Durber). Applicants respectfully traverse this rejection.

Claim 8 recites “controlling the **timing** of each **cutting** of the web material so as to **register** the position of each length of web material with a predetermined location for each length of web material on each individual carton blank” (emphasis added). The examiner states on page 2 of the Office action that “Durber teaches that cutting is controlled using variable speed drive 52 in that drive 52 controls the feeding of the strip material to the cutting operation, and the position of material 26 is placed on the correct position of substrate 36.” However, a review of Durber reveals that it does not, in fact, disclose controlling the timing of the cutting so as to register the position of each length of web material.

Drive pulley 52 of Durber may control the speed of the web material that is introduced onto severing roller 54. But there is no indication in Durber that drive pulley 52 controls the timing of the cutting of the web material, much less in registration with the position on the carton blank as recited in claim 8. Durber does state on page 3, lines 10-14, that “[t]he movement of the blanks and the delivery of the lengths of plastic strip material are synchronized to ensure that the strips are accurately placed in the correct position on the moving blanks.” Utilizing the timing of the cutting to ensure accurate placement of web material, though, is nowhere to be found in Durber.

Claims 1 and 3 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 3,957,570 (Helm). Claims 1 and 5 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,429,576 (Doderer-Winkler). Claims 1, 4 and 5 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 4,589,943 (Kimball *et*

*al.*). Claims 1 and 3 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,224,405 (Pohjola). Applicants respectfully traverse these rejections.

Claim 1 has been amended to recite identifying a predetermined location for each length of web material on each individual substrate and supplying the identified predetermined location information to a controller configured to control the timing of each cutting of the web material. Support for this amendment can be found in original claim 6, which has been cancelled. These steps are not disclosed in Helm, Doderer-Winkler, Kimball *et al.* or Pohjola.

Claims 3, 4 and 5 depend from claim 1 and should be allowable for the same reasons as claim 1. Additional arguments for distinguishing claims 3 and 5 are provided in the following paragraphs.

With regard to the rejection of claim 3 over Helm, the Examiner alleges that “web 16 is upon roll 24’ for a given peripheral degree which is shown to be 180 degrees.” Claim 3, however, recites “the web material advance[ing] on 90 to 200 degrees of the foraminous peripheral surface of the vacuum roll *prior* to being cut.” Claim 3 (emphasis added). No portion of Helm discloses this feature. In Helm Figure 7, which was cited by the Examiner, the web material 16 may advance between rotating cutter 26 and stationary cutter 27 prior to being cut, but the radial distance between rotating cutter 26 and stationary cutter 27 is less than 90 degrees. Helm Figure 7.

Claim 3 has been amended to specify that the web material is advanced over a “*continuous* foraminous peripheral surface of the vacuum roll.” Claim 3 (emphasis added). The apparatus disclosed in Pohjola includes a transfer roll 28 with discrete puck assemblies 54 on its surface. The vacuum ports 142 are found only on the discrete puck assemblies 54, so the surface of the transfer roll 28 cannot be characterized as a continuous foraminous peripheral surface.

With regard to claim 5, Doderer-Winkler fails to disclose “controlling the timing of each cutting of the web material so as to *register* the position of each length of web material with the predetermined location for each length of web material on each individual substrate.” Claim 5 (emphasis added). The portion of Doderer-Winkler cited by the Examiner describes a process for controlling the length of each piece of tape, but this process cannot be used to register the position of each piece of tape with a location on the individual substrates. As shown in Doderer-Winkler Figure 1, the spacing between the pieces of tape is uniform.

### ***III. Claim Rejections - 35 U.S.C. § 103***

Claim 3 was rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Doderer-Winkler. Claims 1, 5-7, 8, 10-11 and 12 were rejected under 35 U.S.C. § 103(a) as

allegedly being unpatentable over U.S. Patent No. 3,986,440 (Macdonald *et al.*) in view of Durber. Applicants respectfully traverse these rejections.

With respect to the rejection of claim 1 over Macdonald *et al.*, the Examiner alleges that Macdonald *et al.* teaches “advancing material B onto at least a portion of a foraminous peripheral surface of a roll 73.” In Macdonald *et al.* the web material is advanced *by* the rollers and not *on* the rollers. In contrast to the vacuum roller of claim 1, the roll 73 disclosed in Macdonald *et al.* only contacts the web material at a nip; it does not carry the web material on its surface. In fact all of the rollers disclosed in Macdonald *et al.* are used only to guide or drive the web material, not to carry the web material. This is evidenced by the small size of the rollers. Macdonald *et al.* Figure 1. Since the web material is not actually carried by the rollers disclosed in Macdonald *et al.*, it would make no sense to modify these rollers to be foraminous or to have any other features for holding the web material onto their surfaces. Since there is no motivation to combine Macdonald *et al.* with Durber, the rejection of claim 1 should be withdrawn. M.P.E.P § 2143.01.

Claim 8 recites cutting the web material at a location on the vacuum roll. In contrast, Macdonald *et al.* discloses cutting the web material with a knife blade 84 that is not located on any rollers. See Macdonald *et al.* Figure 6a. Durber is relied upon simply for showing a vacuum roll. The features of Durber cannot be imported into Macdonald *et al.* without the proper motivation, and there would have been no motivation to modify Macdonald *et al.* with Durber to arrive at the invention recited in claim 8.

#### ***IV. Dependent Claims***

All rejected dependent claims depend from a rejected independent claim and are allowable for the reasons stated for each independent claim. Each of the dependent claims is further allowable in view of the patentable combination of features recited in such dependent claim.

#### ***V. Allowable Subject Matter***

Claims 2 and 9 were objected to as being dependent on a rejected base claim. These claims have been cancelled and rewritten in independent form as new claims 22 and 23. New claims 22 and 23 contain all of the limitations of claim 2 and 9, respectively, plus the limitations of the respective base claims.

**VI. New Claims**

Applicant has added claims 13-23. Support for new claim 13 can be found, for example, in the specification at page 12, lines 3-20 and page 12, line 24 to page 13, line 13. Support for new claims 14 and 15 can be found, for example, in the specification at page 11, lines 14-24 and page 12, line 24 to page 13, line 13. Support for new claims 16 and 17 can be found, for example, in the specification at page 8, line 27 to page 9, line 3 and page 12, lines 3-20. Support for new claim 18 can be found, for example, in the specification at Figures 1-8 and page 11, lines 14-24. Support for new claim 19 can be found, for example, in the specification at page 11, lines 14-24. Support for new claim 20 can be found, for example, in the specification at page 8, lines 3-4 and page 10, lines 14-18. Support for new claim 21 can be found, for example, in original claim 4 and in the specification at page 8, lines 4-18. Claims 22 and 23 correspond to cancelled claims 2 and 9, respectively.

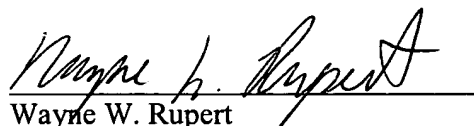
**VII. Conclusion**

It is respectfully submitted that the present claims are in condition for allowance. Should there be any questions regarding this application, Examiner Gray is invited to contact the undersigned attorney at the telephone number shown below.

Respectfully submitted,

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